

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed August 9, 2004. At the time of the Office Action, Claims 1-3, 5-9, 11-15, 17-49, 51-55, and 57-85 were pending in the Application, as Applicant has cancelled Claims 4, 10, 16, 50, and 56 without prejudice or disclaimer. Applicant amends Claims 1, 3, 5, 6, 38, 48, 49, 51, 52, 84, and 85. The amendments to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Many of Applicant's amendments were only made to correct dependency or antecedent basis issues resulting from the cancellation of certain claims. All of Applicant's amendments are without prejudice or disclaimer and have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1, 3, 11, 17, 19, 36, 38-41, 47-49, 57, 63, 65, 82, and 84-85 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,434,616 issued to Urano et al. (hereinafter "*Urano*"). This rejection is respectfully traversed for the following reasons.

Independent Claim 1, as amended, recites a method for providing a network service that includes receiving packet interest instructions from a service manager at a forwarding agent, the instructions specifying packets that the forwarding agent is to communicate to the service manager; receiving an initial packet at a forwarding agent that matches one of the packets specified in the packet interest instructions from the service manager; and communicating the initial packet from the forwarding agent to the service manager so that the packet may be processed at the service manager to determine one or more actions that are to be performed for the packet, wherein the forwarding agent and the service manager are configured on a single network device such that one or more packets may be exchanged between the forwarding agent and the service manager within the network device.

By contrast *Urano* fails to offer any system in the context of the above identified limitations that provides the forwarding agent and the service manager being configured on a single network device such that one or more packets may be exchanged between the forwarding agent and the service manager within the network device.

The Examiner has failed to cite any portion of *Urano* that offers such a disclosure. Additionally, the Examiner is unable to provide such missing disclosure, as the architecture of *Urano* cannot offer such a teaching. Accordingly, Independent Claim 1 is patentable over *Urano* for at least this reason. Additionally, Independent Claims 3, 38, 48, 49, 84, and 85 include a similar limitation and, thus, are also allowable over *Urano* for similar reasons. In addition, the corresponding dependent claims associated with these Independent Claims are also patentable over *Urano* for analogous reasons.

Section 103 Rejections

The Examiner rejects Claims 2, 5, 20, 51, 62, and 66 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,243,748 issued to Arai (hereinafter “*Arai*”). The Examiner rejects Claims 7, 12, 34-35, 37, 53, 58, 80-81, and 83 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,407,997 issued to DeNap et al. (hereinafter “*DeNap*”). The Examiner rejects Claims 8, 13, 54, and 59 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,434,616 issued to Furuichi (hereinafter “*Furuichi*”). The Examiner rejects Claims 9, 14, 55, and 60 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,065,061 issued to Blahut et al. (hereinafter “*Blahut*”). The Examiner rejects Claims 15, 43, and 61-62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Publication No. 2002/0126622 issued to Kimball et al. (hereinafter “*Kimball*”). The Examiner rejects Claims 18 and 64 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,070,187 issued to Subramaniam et al. (hereinafter “*Subramaniam*”). The Examiner rejects Claims 21-33, 42, 44-46, and 67-79 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,172,980 issued to Flanders et al. (“*Flanders*”). These rejections are respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the

claim limitations.¹ It is respectfully submitted that these rejected Claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

The Independent Claims have been shown to be allowable in the §102 analysis above, as they are distinguishable over *Urano*. Furthermore, these secondary references do not provide any disclosure that is combinable with *Urano* that could inhibit the patentability of the pending claims. Thus, the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis according to MPEP §2143. Accordingly, these rejected claims are also allowable over the references cited by the Examiner based on, at least, this reason. Therefore, all of the pending claims have been shown to be allowable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of the pending claims.

¹ See M.P.E.P. § 2142-43.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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